

REMARKS

Claims 2-5, 13, 14, and 16 have been canceled. Claim 1 has been amended to further delimit the description of the microvoids by incorporating the limitations for which the bases are provided below. Claims 6-8, 15, 18, 21, 22, 26, and 28 have been amended to resolve the specific Section 112 concerns of the Examiner. Support for the claims is as described below:

Claims	Support
1	Original claims 3, 13, 16, 19, 20, Example 3, Specification Page 7/lines 13-20; 28/lines 25-27
7	Specification Page 7, lines 11-12
8	Specification Page 20, lines 18-19
15	Specification Page 11, lines 14-18
26	Specification Page 14, lines 9-13

Claims 19, 23-25, 27 and 30-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected invention or species. It is noted that claims 19, 23-25, and 27 are withdrawn species claims entitled to further consideration upon the allowance of a generic claim.

The first sentence of the specification has been amended to incorporate appropriate references of related co-pending applications.

Section 112 Rejections

Claims 1-18, 20-22, 26, 28 and 29 stand rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The Examiner notes that the language of claim 1 is vague, indefinite, functional, and fails to give notice as to what constitutes infringement upon the instantly claimed invention. The Examiner cites See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). It is respectfully noted, however, that the inclusion of functional limitations is not a valid basis for rejection provided that the bounds of the invention can readily be determined by simple experimentation. See *In re Fisher*, 135 USPQ 22 (CCPA 1962); *In re Swinehart et al.*, 169 USPQ 226 ((CCPA

1971); In re Roberts, 176 USPQ 313, (CCPA 1973). There is nothing intrinsically wrong in defining something by what it does rather than what it is. In re Hallman 210 USPQ 609, (CCPA 1971) A claim is not indefinite merely because it is functional. In re Miller, 169 USPQ 597 (CCPA 1971).

The present amendment provides further delimitation of the void description and thus substantially reduces the scope of the voided films covered by the claims. The range of dimensions for the voids is provided as is the range of void volume per square centimeter which together with the range of dimensions of the individual voids serves to limit the frequency of the voids. The presently amended claim 1 distinctly limits the parameters of the voids to be used. It further functionally limits the claims so that the scope does not extend to a light diffuser that fails to meet the color temperature requirements of the claim. This is acceptable claim functionality in accordance with the foregoing cases and is not “merely setting forth physical characteristics desired in an article”.

Double Patenting

Claims 1, 6-9, 11, 14, 15-17, 18, 21 and 22 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over 1, 11-14, 2, 1, 23-25, 27, 30 and 31, respectively, of amended copending Application No. **10/017,002** (5/26/2004). Although the conflicting claims are not identical, they are not patentably distinct from each other because although Application ‘002 discloses additional structure not claimed, Application ‘002 does claim the same invention as claimed. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 6, 7, 9, 10, 11-16, 21, 22, 26, 28 and 29 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21, 16, 17, 18, 19, 21-26, 30, 31, 32, 34 and 8, respectively, of amended copending Application No. **10/020,404** (12/12/2003). Although the conflicting claims are not identical, they are not patentably distinct from each other because although Application ‘404 discloses additional structure not claimed, Application ‘404 does claim the same invention as claimed. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 6-9, 10, 11-17, 21 and 22, stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2-5, 8, 10-16, 21 and 22, respectively, of amended copending Application No. **10/017,402** (filed 12/14/2001). Although the conflicting claims are not identical, they are not patentably distinct from each other because although Application '402 discloses additional structure not claimed, Application '402 does claim the same invention as claimed. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Enclosed is a suitable Terminal Disclaimer overcoming the Double Patenting rejection based on the three cited applications.

Prior Art Rejections

Claims 1-18, 20-22, 26, 28 and 29 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al. (US 6,057,961). According to the Examiner:

Allen's invention is directed to an optical film which exhibits increased gain at non-normal angles of incidence and which comprises a disperse phase of polymeric particles disposed within a continuous birefringent matrix. The film is stretch oriented in one or more directions. The size and shape of the disperse phase particles, the volume fraction of the disperse phase, and the film thickness are chosen to attain a desired degree of diffuse reflection and total transmission of electromagnetic radiation of a desired wavelength in the resulting film (Abstract). In some embodiments, the materials of the continuous and disperse phases may be chosen so that the interface between the two phases will be sufficiently weak to result in microvoiding when the film is oriented. The average dimensions of the voids may be controlled through careful manipulation of processing parameters and stretch ratios, or through selective use of compatibilizers (column 22, lines 4-14).

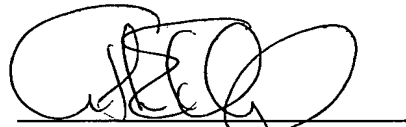
For claims 1-5, 7, 8, 11, 12 and 15-17, Allen lacks the specific teachings of the light transmission efficiency at 500nm, the amount of average weight-balanced color temperature variation, the number of times the refractive index changes in the light path, and the volume fraction of microvoids. However, it is noted that Allen does teach the size and shape of the disperse phase particles, and the volume fraction of the disperse phase and the film thickness (which reads on the frequency of the microvoids and the number of times the refractive index changes) are chosen to attain a desired degree of diffuse reflection and total transmission of electromagnetic radiation of a desired wavelength in the

resulting film, as set forth above. Further, Allen expressly teaches that the films exhibit a flat transmission curve as a function of the wavelength of light, which tends to minimize any changes (variation) in color to a resultant display device (column 5, lines 30-34). As such, in the absence of unexpected results, since Allen teaches essentially the same subject matter as the instantly claimed invention, i.e., a microvoided polymeric light diffuser, it is believed that the aforementioned elements are either inherently disclosed by Allen, or obvious optimizations to one of ordinary skill in the art of polymer film light diffuser, motivated by the desire to obtain a light diffuser with minimal color changes, as taught by Allen. It should be noted that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. See MPEP § 2112.01.

It is noted that there is no basis in Allen et al. for arriving at the selection of film parameters of the present invention. The Examiner's attention is directed to Table 1 at page 37 of the present specification. It is clear from the data in the table that the control of the color temperature variation is significantly affected by the parametric arrangement of the diffuser film. The values in the bottom four rows of the table are a measure of the color temperature variation at different angles of view. These values vary widely depending on the film parameters including size, volume and frequency of the voids. The comparative first and last two columns exhibit variations of 130, 84, and 67 °K ΔT , respectively. No teaching or suggestion could be found in Allen et al. as to the parameters of voids to be employed to accomplish an improvement in the ΔT result. On the other hand, the ΔT values for examples 1-5 are not more than 40°K and, for Example 3, not more than 20 °K. No basis could be found in Allen et al. for arriving at the desired improvement.

In view of the foregoing amendments and remarks, the Examiner is respectfully requested to withdraw the outstanding rejection and to pass the subject application to Allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'A. Kluegel', written over a horizontal line.

Attorney for Applicant(s)
Registration No. 25,518

Arthur E. Kluegel/dlm
Rochester, NY 14650
Telephone: 585-477-2625
Facsimile: 585-477-1148

Encl: Terminal Disclaimer (Provisional/3 Applications)